



ALSTON & BIRD LLP
BANK OF AMERICA PLAZA
101 SOUTH TRYON STREET, SUITE 4000
CHARLOTTE NC 28280-4000

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APR 21 2004

In re Application of
Date, et al.
Application No. 10/615,571
Filed: July 8, 2003
Attorney Docket No. 041309/262110
For: OPTICAL DEVICE AND DISPLAY
APPARATUS

OFFICE OF PETITIONS
DECISION DISMISSING
PETITION

This is a decision on the petition filed February 19, 2004 (certificate of mailing date February 16, 2004) requesting, in effect, withdrawal of a Notice mailed January 23, 2004. The petition will be treated under 37 CFR 1.53(e).

The petition under 37 CFR 1.53(e) is **DISMISSED**.

The application was filed on July 8, 2003. However, on January 23, 2004, The Office of Initial Patent Examination mailed a "Notice of Omitted Item(s) in a Nonprovisional Application" (Notice) stating that the application had been accorded a filing date of July 8, 2003, and advising applicants that pages 93-113 of the specification appeared to have been omitted.

In response to the Notice, petitioners timely filed the present petition. Petitioners request that Office accord a July 8, 2003 filing date for pages 93-113 of the specification on the basis that the allegedly omitted pages were received in the Patent and Trademark Office (PTO) on July 8, 2003. In support, the petition is accompanied by a declaration of a support staff member of Alston & Bird LLP, Ms. Gwen Frickhoeffer, who reviewed the application and attests to the fact that pages 93-113 were present.

The declaration submitted with the petition states without equivocation or doubt that Ms. Frickhoeffler checked the assembled application papers to determine that the application included all pages of specification.

The Office file is the official record of what was filed on July 8, 2003. An applicant alleging that a paper was filed in the Office and later misplaced has the burden of proving the allegation by a preponderance of the evidence. In this regard, declarations by individuals involved in the preparation and mailing of the original application reciting their personal recollection or belief of what was contained in the application that they reviewed and/or mailed are no more persuasive of what was actually mailed than the contents of the official record. Such declarations are usually made months after the actual events recited. In this case, the declaration was made on February 16, 2004, more than seven (7) months after the application was actually mailed.

It is for this reason that the Office has established a practice of providing a receipt for papers filed in the Office to any applicant desiring a receipt. The practice, which was long ago established and is well publicized, requires that any paper for which a receipt is desired be filed in the Office with a self-addressed postcard identifying the paper. A postcard receipt which itemizes and properly identifies the papers which are being filed serves as *prima facie* evidence of receipt in the Office of all the items listed thereon on the date stamped thereon by the Office. See section 503, Manual Of Patent Examining Procedure (MPEP 503). However, if the postcard receipt has been

annotated to indicate that a particular item denoted on the postcard was not received by the USPTO, the postcard receipt will not serve as prima facie evidence of receipt of that item in the USPTO. MPEP 503. Petitioners have not submitted their itemized postcard receipt.¹ Petitioners have not proven that pages 93-113 were present in the Office on July 8, 2003.

In the alternative, petitioners argue that pages 93-113 should be included with the papers filed on July 8, 2003, because they were originally filed in prior application No. 09/361,856, the entire disclosure of which was incorporated by reference at the time of the present application's filing.

Applicants seek to add the pages to the present application on the basis that the pages are not new matter. However, no petition is necessary for that purpose. Additional pages of specification may be entered by the primary examiner without a petition so long as the pages contain no new matter. See MPEP § 608.02(a).

MPEP 201.06(c) states that:

... an applicant may incorporate by reference the prior application by including, in the application-as-filed, a statement that such specifically enumerated prior application or applications are "hereby incorporated herein by reference." The statement may appear in the specification or in the application transmittal letter. The inclusion of this incorporation by reference of the prior application(s) will permit an applicant to amend the continuing application to include any subject matter in such prior application(s), without the need for a petition. (emphasis supplied)

If applicants desire that pages 93-113 be added to the application, the appropriate procedure is by way of amendment requesting the entry of the pages. Any such amendment should be filed prior to the first action on the merits and will be considered by the primary examiner.

Accordingly, the petition is inappropriate and is subject to dismissal.

The petition fee will not be refunded, since the petition was not necessitated by any error on the part of the Office.

The application will be forwarded to Technology Center 3600 for examination in due course. Pages 93-113 will not be processed at this time.

Telephone inquiries specific to this matter should be directed to the undersigned at (703) 308-6712.



E. Shirene Willis
Senior Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

¹ It is noted that the transmittal letter in the application file has been annotated with "The PTO did not receive the following listed item(s) 93 - 113 pages of specification."